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PATENT APPLICATION NO.
09/675,415

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**In The United States Patent and Trademark Office
On Appeal From The Examiner To The Board
of Patent Appeals and Interferences**

In re Application of: James M. Crawford Jr. et al.
Serial No.: 09/675,415
Filing Date: September 29, 2000
Examiner: Raquel Alvarez
Art Unit: 3622
Title: *System and Method for Rendering Content According to
Availability Data for One or More Items*

Mail Stop: Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

<p style="text-align: center;">CERTIFICATE OF MAILING BY EXPRESS MAIL Exp. Mail Receipt No. EV 323312605 US</p> <p>I hereby certify that this communication is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" under 37 C.F.R. § 1.10 on the date indicated below and is addressed to Commissioner For Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.</p> <p><i>Willie Jiles</i></p> <p>Willie Jiles</p> <p>Date: February 21, 2005</p>

Reply Brief

Appellants respectfully submit this Reply Brief under 37 C.F.R. § 41.41(a)(1) in response to the Examiner's Answer mailed December 30, 2004.

Appellants filed an Appeal Brief on October 4, 2004, explaining clearly and in detail why the final rejection of Claims 1-43 is improper and the Board should reverse this final rejection. As explained in more detail below, the Examiner's final rejection of these claims cannot be properly maintained. Appellants respectfully request the Board to reverse this final rejection and instruct the Examiner to issue a Notice of Allowance with respect to these claims.

Argument

The rejection of Claims 1, 4-5, 8-13, 15, 18-19, 22-27, 29-30, 33-34, and 37-42 based on *Cragun* under 35 U.S.C. § 102(b) is improper, and the Board should reverse this rejection. The rejection of Claims 6-7, 14, 20-21, 28, 35-36, and 43 based on *Cragun* under 35 U.S.C. § 103(a) is improper, and the Board should reverse this rejection. The rejection of Claims 2-3, 16-17, and 31-32 based on *Cragun* in view of *Linden* under 35 U.S.C. § 103(a) is improper, and the Board should reverse this rejection.

**Appellants' Appeal Brief Includes a Statement Regarding
Related Appeals and Interferences**

In the Examiner's Answer, the Examiner states:

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(Examiner's Answer, Page 2).

Appellants disagree with the Examiner. Appellants' Appeal Brief clearly states, "No known appeals, interferences, or judicial proceedings are related to or will directly affect or have a bearing on the Board's decision on this Appeal. The Board's decision on this Appeal will not affect any known appeals, interferences, or judicial proceedings." (Appellants' Appeal Brief, Page 2).

Appellants' Claims are Allowable Over the Cited References

Section 10 of the Examiner's Answer consists entirely of material repeated verbatim from the Final Office Action mailed February 12, 2004. Section 11 of the Examiner's Answer consists of four paragraphs. The first, second, and fourth paragraphs consist of new material responding to arguments in Appellants' Appeal Brief, while the third paragraph consists entirely of material repeated verbatim from the Final Office Action mailed February 12, 2004. Below, Appellants specifically address the new material in the first, second, and fourth paragraphs of Section 11 of the Examiner's Answer.

In the first paragraph of Section 11 of the Examiner's Answer, the Examiner asserts that *Cragun* "clearly teaches that the user request to purchase an item is sent to a server in order for the request to be fulfilled" and that, therefore, *Cragun* discloses ***generating at least one availability request corresponding to the rule and concerning the item***, as recited in Appellants' independent claims. Appellants disagree with the Examiner. Contrary to the Examiner's assertion, *Cragun* does not disclose that "the user request to purchase an item is sent to a server in order for the request to be fulfilled." Nowhere does *Cragun* disclose a "user request" or even a "request." *Cragun* discloses only that, when a customer purchases items, information-collection devices collect information on the purchase and communicate the collected information to a computer system that then analyzes the collected information to identify items missing from the purchase that are members of a class of items represented in the purchase. The identified items become the subject of a sales promotion that an output device communicates to the customer. Nowhere does *Cragun* even suggest that the purchase involves a request that is later fulfilled. Instead the customer's purchase is complete at the time of the transaction. Moreover, even assuming for the sake of argument that *Cragun* disclosed that "the user request to purchase an item is sent to a server in order for the request to be fulfilled," as the Examiner asserts, such disclosure would still fail to disclose, teach, or suggest ***generating at least one availability request corresponding to the rule and concerning the item***, as recited in Appellants' independent claims. As just an example, such

disclosure would still fail to disclose, teach, or even suggest that the user request *corresponds to any rule*, as recited in Appellants' independent claims.

Also, in the first paragraph of Section 11 of the Examiner's Answer, the Examiner also asserts that *Cragun* "teaches . . . that an item # corresponds to a stock number, inventory number and Figure 4 illustrates using the item # to recommend an item based on the item #, which corresponds to a stock and inventory number for the item selected by the user," which the Examiner indicates supports the Examiner's assertion that *Cragun* discloses ***generating at least one availability request corresponding to the rule and concerning the item***, as recited in Appellants' independent claims. Appellants disagree with the Examiner. Contrary to the Examiner's assertion, *Cragun* does not disclose "that an item # corresponds to a stock number, inventory number and Figure 4 illustrates using the item # to recommend an item based on the item #, which corresponds to a stock and inventory number for the item selected by the user." Nowhere does *Cragun* disclose a "user." Therefore, *Cragun* also necessarily fails to disclose, teach, or suggest "the item selected by the user." *Cragun* merely discloses that an item number identifies a product and corresponds to a stock number, inventory number, or the like. Moreover, even assuming for the sake of argument that *Cragun* disclosed "that an item # corresponds to a stock number, inventory number and Figure 4 illustrates using the item # to recommend an item based on the item #, which corresponds to a stock and inventory number for the item selected by the user," as the Examiner asserts, such disclosure would still fail to disclose, teach, or suggest ***generating at least one availability request corresponding to the rule and concerning the item***, as recited in Appellants' independent claims. As just an example, such disclosure would still fail to disclose, teach, or suggest that the item number, stock number, or inventory number has any bearing whatsoever on *availability*, as recited in Appellants' independent claims.

In the second paragraph of Section 11 of the Examiner's Answer, the Examiner asserts that, in *Cragun*, "the items are classified and categorized in classes and according to its class, it recommends the additional items" and that, therefore, *Cragun* discloses

identifying at least one rule within the user-requested content and concerning the item, as disclosed in Appellants' independent claims. Appellants disagree with the Examiner. Even assuming for the sake of argument that the above classification of items could be properly considered *at least one rule*, as recited in appellants' independent claims, *Cragun* would still fail to disclose, teach, or suggest that the classification of items is somehow *within user-requested content*, as recited in appellants' independent claims.

In the fourth paragraph of Section 11 of the Examiner's Answer, the Examiner asserts that the proposed *Cragun-Linden* combination, on which the Examiner relies to reject Claims 2-3, 16-17, and 31-32, is proper. Appellants disagree with the Examiner. The Examiner merely states that "Cragun can be combined to include the server being a web server as taught by Linden because such a modification would provide world access to the system" and that, "[g]iven the web server of Linden, one of ordinary skill in the art would have the knowledge or would know that the server being a web server would allow broader use of the system." Such statements fail to demonstrate that *Cragun*, *Linden*, or knowledge that was generally available to a person having ordinary skill in the art at the time of the invention would have provided any teaching, suggestion, or motivation to even attempt—much less actually—combine the references with each other as proposed. Actual evidence of such a teaching, suggestion, or motivation is clearly required by the M.P.E.P. and governing Federal Circuit case law, as discussed at length in Appellants' Appeal Brief and reiterated here. The Examiner's failure to provide the required evidence is fatal to the Examiner's rejections based on the proposed *Cragun-Linden* combination.

For at least these reasons, Appellants' claims are patentable over the cited references. Appellants submit that the rejection of Appellants' claims is improper and the Board should reverse this rejection.

Conclusion

Appellants have demonstrated that the present invention, as claimed, complies with all statutory requirements for a U.S. Patent. Therefore, Appellants respectfully request the Board to reverse the final rejection of the Examiner and instruct the Examiner to issue a Notice of Allowance with respect to all pending claims.

Appellants believe no fees are due. Nonetheless, the Commissioner is hereby authorized to charge any fee and credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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